

Serial No. 08/918,944  
Docket No. 099302

respectfully submit that the antecedent basis for the cited claim limitations are found at least on page 9, lines 6-14, of the disclosure.

The Examiner also objected to claims 19-20 for informalities. Applicants respectfully note that claims 19-20 have been canceled without prejudice or disclaimer.

Claims 1-20 were rejected under § 112, second paragraph, as being indefinite for using the term “system” and for use of other phrases. Applicants respectfully thank the Examiner for suggesting that the claims be directed to a “device”, rather than a “system.” Applicants note that claims 1-20 have been canceled without prejudice or disclaimer and that, consistent with the Examiner’s suggestion, newly added claims 31-43 are directed to a “device.”

The Examiner further rejected claims 1-7 and 9-21 under § 103(a) as being unpatentable over U.S. Patent No. 5,586,766 to Forte et al. in view of U.S. Patent No. 5,788,573 to Baerlocher et al. The Examiner also rejected claim 8 under § 103(a) as being unpatentable over Forte et al. in view of Baerlocher et al and further in view of U.S. Patent No. 5,524,888 to Heidel. Applicants respectfully note that claims 1-21 have been canceled without prejudice or disclaimer. To the extent that these rejections remain applicable to the pending newly added claims 22-43, the rejections are respectfully traversed, as follows.

At the outset, Applicants respectfully note that the Examiner drew to the Applicants’ attention U.S. Patents Nos. 5,707,285 to Place et al., 5,141,234 to Boylan et al., and 5,098,107 to Boylan et al. during the interview with Applicants’ representative conducted

Serial No. 08/918,944  
Docket No. 099302

May 6, 1999. Applicants respectfully request that, to the extent relevant to examination of the pending claims, the Examiner indicate his consideration of these patents.

Applicants respectfully submit that newly added claim 22 is allowable over the prior art of record at least for the reason that claim 22 relates to a method of playing card game played in conjunction with an auxiliary game that includes a limitation for providing a player an option to select to advance at least one tier in the auxiliary game. Specifically, Applicants respectfully submit that neither Forte et al. nor the patent to Baerlocher et al., nor the combination of these patents, teach or suggest at least the option limitation, as claimed. Claims 23-25, which depend from claim 22, provide further limitations relating to bonus events occurring and the option to select to advance. Specifically, claim 23 provides for the bonus event to occur upon the dealing of a preselected card, claim 24 provides that the option includes playing the preselected card in the auxiliary game to advance a bonus level, and claim 25 clarifies that the option further includes selecting to play the preselected card in the card game. Applicants respectfully submit that none of these features is either taught or suggested by Forte et al. or Baerlocher et al. or by the combination of these references.

Claims 26-30, which also depend from claim 22, detail additional limitations that patentably distinguish the present invention over the prior art of record. Specifically, claim 26 relates to the bonus event occurring at least once upon dealing of all of the cards, and claims 27-30 detail features relating to generating the random prize from a plurality of predetermined prizes. Applicants respectfully submit that none of these features is either

taught or suggested by Forte et al. or Baerlocher et al. or by the combination of these references.

Similarly to claim 22, Applicants respectfully submit that independent claim 31 is patentable over the prior art of record, in that claim 31 relates to a device for playing a card game in conjunction with playing an auxiliary game, the auxiliary game providing an option for a player to optionally select to receive a bonus point in the auxiliary game. Applicants respectfully submit that none of these features is either taught or suggested by Forte et al. or Baerlocher et al. or by the combination of these references.

Likewise, Applicants respectfully submit that claims 32-42, which depend from claim 31, are patentable over the prior art of record. Claim 32 provides for the bonus event to occur upon dealing of a preselected card, claim 33 provides that the option includes playing the preselected card in the auxiliary game to advance a bonus level, and claim 34 clarifies that the option includes selecting to play the preselected card in the card game. Claims 35 and 36 provide further limitations relating to an event occurring to prevent use of the preselected card, and the event being a bust event. Claim 37 provides the limitation of the player interface units including a player control element that includes a selector for selecting a prize; claim 38 relates to a prize display operatively coupled to the controller; claims 39 and 40 provide limitations relating to a randomizer operatively coupled to the controller for selecting among a plurality of prizes having probabilities of selection; and claims 41 and 42 relate to a dealer interface unit. Applicants respectfully submit that none of these features is

either taught or suggested by Forte et al. or Baerlocher et al. or by the combination of these references.

Further, with regard to the rejection under § 103, Applicants respectfully submit that the Examiner has not yet set forth a prima facie case of obviousness. The PTO has the burden under § 103 to establish a prima facie case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could be modified to meet the claim is insufficient to establish obviousness. The PTO “can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so). In the Office Action, the Examiner restates the advantages of the present invention to justify the combination of references using hindsight. There is, however, nothing within the applied references to evidence the desirability of making the combination suggested by the Examiner.

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the prior art of record. Accordingly,

Serial No. 08/918,944  
Docket No. 099302

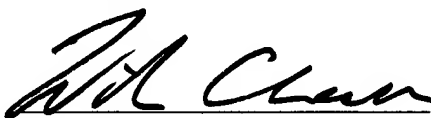
reconsideration and withdrawal of the outstanding prior art rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

Respectfully submitted,

Thomas E. SAWYER et al.

By:



Wilburn L. Chesser

Registration No. 41,668

JONES JAIN, L.L.P.  
Suite 1150  
1110 Vermont Avenue, N.W.  
Washington, D.C. 20005  
(202) 955-3610  
Date: 5/6/99